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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/642,891

08/18/2003

Fritz Tollner

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07/19/2005

MERCHANT & GOULD PC

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EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/642,891

Applicant(s)

TOLLNER, FRITZ

Examiner

Paul Marcantoni

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1, 10 and 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9, 11, 12 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

The applicants' 1/13/05 election with traverse of Group II, claims 11-12, drawn to a process of making a concrete article, is based upon an incomplete response because applicants do not provide specific reasons for why they think the examiner's restriction requirement is improper. The restriction is thus FINAL. On 4/7/05, the applicants responded to the examiner's election of species requirement by selecting *polyacrylates* for the thickening agent and *waxes* for the hydrophobic additives.

35 USC 112 and 35 USC 132 New Matter:

Claims 16-18 are rejected under the first paragraph of 35 USC 112 and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

These new claims would appear to be new matter unsupported by the original disclosure and original claims. Should applicants provide the specific location from the original disclosure/claims wherein they obtain support, these rejections will be promptly withdrawn.

35 USC 112-Second Paragraph:

Claims 2-9, 11, 12, and 16-18 are rejected under the second paragraph of 35 USC for failing to particularly point out and distinctly claiming the instant invention. Claim 11 and its dependent claims, as a result of claims 3 and 5, are indefinite. There is no distinction between "polyacrylates" (thickener) which is inclusive of polyacrylate resin (hydrophobing additive), "polyurethanes" (thickener) and polyurethane resin (hydrophobing additive), and "silicic acid derivatives" (thickener) and silicic acid esters (hydrophobing additive). Note that polyacrylate resin is inclusive of the genus

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polyacrylates and polyurethane resin is inclusive of the genus polyurethanes. Further, silicic acid esters are an example of silicic acid derivatives and there is thus no distinction between "thickener" and "hydrophobing agent".

Claim 11 is also indefinite because it is unclear how an article can be made in claim 11 as there is no step of molding. It is evident applicant are creating a cement mixture but there is no step of molding, setting, and curing which would be requisite of forming a cement/concrete article.

35 USC 103:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-9, 11, 12, and 16-18 are rejected under 35 USC 103 over Butler et al. (US 5,766,323) as rendering obvious the applicants' claimed invention.

Butler et al. (hereafter Butler) teaches a method of making a cementitious material. It would have been obvious to one of ordinary skill in the art that a cementitious article is made from a cementitious material. Butler teaches that he mixes cement, water, polyacrylate beads (thickener-see claim 14 in col.10), polyoxyethylene wax (claim 13 in col.10-has hydrophobing properties because it's a "wax" as that is all that is required in applicants' claims), and organopolysiloxane (also a hydrophobing additive). The applicants' further addition of surfactants, air pore formers (ie air entraining agents), retarders, accelerators, colorants such as dyes and pigments etc.

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are merely conventional additive known for addition to cement or concrete compositions (see col.3, lines 35-43).

Further, the applicants addition of a thickener as part of one component with thickener and hydrophobing additive as not unobvious over the prior art either. Applicants merely add these two ingredients together or simultaneously as one component when it would have been an obvious design choice to add the ingredients simultaneously or individually one at a time. Changes in the sequence of adding ingredients would have been an obvious design choice absent evidence to the contrary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni  
Primary Examiner  
Art Unit 1755